

Patent Drafting for Beginners
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Lecture-15
What is Patentability Search

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Patentability Search

- Search for Obviousness
- Search for Inventive Step
- Patentability search not directed towards novelty
- S.13 – Search for anticipation by previous publication or Prior claim



What is a patentability search? Contrary to popular belief, a patentability search is an effort; that is directed towards determining whether an invention is obvious or not. Patentability searches are directed towards seeing whether an invention involves an inventive step. It is not directed towards determining whether an invention involves novelty.

Now, this is a distinction that is important to be understood and to be established at the outset. There is a provision in the Indian patents act. Section 13, which calls for a search for anticipation by previous publication or by prior claim. Now in other words, this is a search that is done by an examiner when an application is filed.

The objective of this search is to ensure that the invention as it is covered in a patent application has not been anticipated. So, in common parlance when you talk about a search, it is easy for somebody to focus on a search for novelty. But patentability searches throughout the world are directed in determining whether there is inventive step, or whether the invention is obvious or not.

Now, the reason an applicant may want to do a patentability search is to determine the chances of obtaining a patent. Because once you are reasonably confident about the inventive step, then the chances of the patent being granted other things being satisfied are much better.

Now, in a patentability search, there are a series of events that normally happens which culminates into a patentability search . By convention, especially in the advanced jurisdictions like united states, a patentability search is not done by the patent attorney. It is not the person who drafts the patent who does the search. It is done by a different set of professionals called searchers.

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List of Sequences

1. Search Request
 - Time and Cost
 - Defines the invention
2. Searching for the references using patent databases
3. Review the references
4. Report the results



So, let me just list the list of sequences that would normally happen when a patentability search is requested for. Number one, a search request is made by the patent attorney to the searcher. And this search request would indicate what is the time and cost that has to be expended in the search. Because that is critical. It defines the invention, or the disclosure of the invention which needs to be searched. And it also gives some broad categories of areas where the patent has to be searched for.

Once this is done, the second step will be to actually do the search. And this search is done by the searcher. Once the search is done, the third step would be to review the references developed by the searcher. Because a searcher may use a free database like a database provided by the various patent offices or by free patterns online or by google,

googles patent search. Now the what what the searcher would do is he will first collect a set of references. Now the third step involves reviewing these references. And the 4th step would be to report the results to the client, which could be the inventor himself, if the searcher is directly dealing with the inventor or the patent attorney.

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Implications in Patentability search

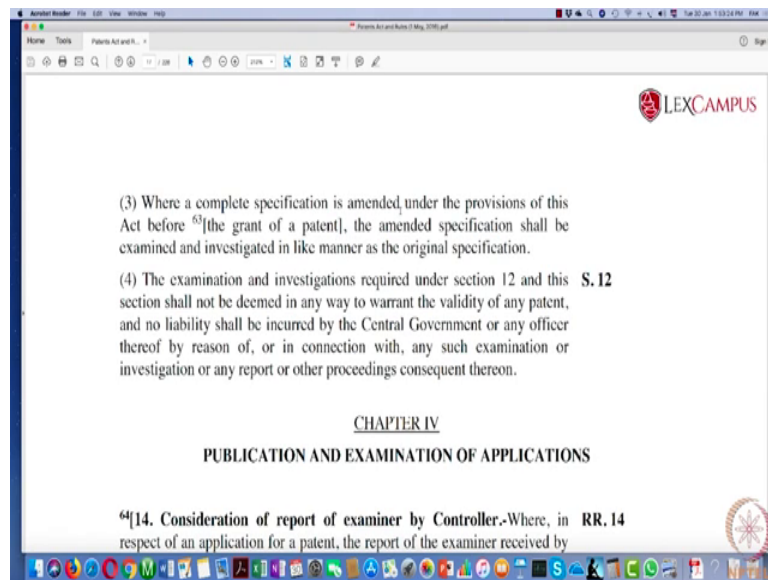
- Does not warrant the validity of any Patent
- Different from enquire of validity of a Patent
- S.12 and S.13 refers to aspect of search
- S.64 refers to the aspect of validity



How this report is communicated can have certain implications in patent law. Now one thing that needs to be understood well is that a patentability search is not a search of validity. When you do a patentability search, when you do a search, it does not guarantee or it does not warrant the validity of an invention.

Now, this is clear from the language of section 13 4, now we have section 13 here.

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And section 13 4 tells us that the examination and investigations required under section 12, which is done by the patent office and this section which is section 13 shall not be deemed in any way to warrant the validity of any patent.

This tells us that the search does not warrant the validity of a patent. This also tells us a patentability search is much different from a inquiry into the validity of a patent. Now section 12 and 13 deals with aspects of search aspects of validity are dealt in section 64, which lists the grounds on which a validity can be questioned.

So, these 2 things are completely different. So, you need to bear in mind that a patentability search is not a report on the validity of a patent. The validity of a patent requires a much more in depth analysis, and the validity report will actually give make a statement on whether the patent is valid, what are the conflicting reasons, or the give that give out the reasons why the patent should not be granted, or why why it can be invalidated, in case of a granted patent.

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Patent validity report

- Initiated by a Defendant in an Infringement Suit
- Initiated by a Patentee to challenge the invalidity questioned by the defendant
- Initiated by a licensee



Now, a validity report or what we call a patentability study would be used in at least 3 different situations. One, it could be generated by a defendant in a patent infringement suit; where the defendant wants to raise a counterclaim to invalidate the patent.

So, a counterclaim or the defense of invalidity can be raised in a patent infringement suit by the defendant. So, for the defendant to know whether the patent is valid or not, the defendant could initiate a validity study. Now the second instance could be where the patentee could ask for a validity study to ensure that he has a good chance of surviving on patent infringement suit; where invalidity has been questioned. The third scenario where a validity study will be relevant is to ensure that licensee or a person who is trying to buy out patent can have an understanding on how much the patent is worth. So, the it is an equivalent for or it could be used as a measure for understanding the value of a patent.